

REMARKS

Claims 1-58 are currently pending in this application, with claims 1, 11, 30 and 43 being independent. Claims 2, 4, 6-11, 29-31, 37, 42, 46, 48 and 50 have been amended to more appropriately define the present invention, claims 38-41 have been amended to modify claim dependencies, and claims 53-58 have been added to define additional aspects of the invention.

Specification

In the Office Action, the Examiner reminded Applicants to fill in the blank space found on page 23 of the specification. Applicants have amended the specification to update the information regarding the filed applications listed therein.

Claim Rejection - 35 U.S.C §112, Second Paragraph

The Examiner rejected claims 2, 4-10, 30-42, 46 and 48-52 under 35 U.S.C §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter of the invention.

Regarding claim 2 (Office Action: Item 4), while Applicants do not concede the propriety of the Examiners rejection, Applicants amend claim 2 to advance the prosecution of the application. Applicants submit that one of ordinary skill in the art would understand the metes and bounds of this claim. Applicants further

submit the use of the word "from," which may be used to "indicate a source, cause, agent, or instrument" (See *American Heritage Dictionary of the English Language*, Fourth Editions, 2000) is properly used in claim 2. Applicants respectfully direct the Examiner's attention to, at least, paragraph [051] of the specification, where, for example, it set forth that the system may include a base provided with a position coding pattern. Applicants therefore submit that one of ordinary skill in the art would be able to determine the metes and bounds of claim 2 in light of the specification, and respectfully request the Examiner withdraw the \$112, second paragraph, rejection of claim 2.

Regarding claims 4, 6 and 8 (Office Action: Items 5 and 8), without conceding the propriety of the Examiner's rejection, Applicants have amended claims 4, 6 and 8 to remove the term "only" in order to advance the prosecution of the application. Applicants further submit that this amendment in no way narrows the scope of claims 4, 6, and 8. One of ordinary skill in the art would be able to ascertain the meaning of these claims. Applicants therefore respectfully request the Examiner to withdraw the \$112, second paragraph, rejection of claims 4, 6 and 8, and any claims depending therefrom.

Regarding claims 4, 5, 7 and 8 (Office Action: Items 6, 7 and 8), Applicants submit that the explicit recitation of the order of the steps is not required to render a method claim definite. When read in light of the specification, one of ordinary skill in the art can ascertain one or more orders of the steps within the metes and bounds of the claimed subject matter for claims 4, 5, 7 and 8. Moreover, Applicants submit they are not obligated to set forth any specific order for the recited steps under §112, second paragraph, and request the Examiner to withdraw the rejection to these claims and claims 9 and 10 depending therefrom. If the Examiner maintains the §112, second paragraph, rejection based upon this ground, Applicants respectfully request the Examiner provide competent legal authority to justify the basis for the rejection.

Regarding claim 10 (Office Action: Item 9), without conceding the propriety of this rejection, Applicants have amended claim 10 to advance the prosecution of the application. Applicants submit one of ordinary skill in the art would be able to ascertain the meaning of this claim, and respectfully request the Examiner to withdraw the §112, second paragraph, rejection of claim 10.

Regarding claim 20 (Office Action: Item 10), Applicants submit one of ordinary skill in the art would appreciate the meaning of this claim, when read in light of the specification. The Examiner

is respectfully referred to, at least, paragraph [039] of the specification, wherein, for example, it is disclosed that "the access-protected unit may be integrated with the user unit. The access may then apply to the user unit itself." Accordingly, Applicants respectfully request the Examiner withdraw the \$112, second paragraph, rejection of claim 20.

Regarding claim 30 (Office Action: Item 11 and 12), without conceding the propriety of this rejection, Applicants have amended claim 30 to advance the prosecution of the application and more appropriately define the present invention. Applicants submit one of ordinary skill in the art would be able to ascertain the meaning regarding "at least one coordinate area" when this feature is read in light of the specification, and therefore respectfully request the Examiner to withdraw the \$112, second paragraph, rejection of claim 30 and claims 31-42 depending therefrom.

Regarding claim 31 (Office Action: Item 12 (sic) -on page 3-), without conceding the propriety of this rejection, Applicants have amended claim 31 to advance the prosecution of the application and more appropriately define the present invention. Applicants submit one of ordinary skill in the art would be able to ascertain the meaning of claim 31 when read in light of the specification, and

therefore respectfully request the Examiner to withdraw this §112, second paragraph, rejection.

Regarding claims 34 and 36 (Office Action: Items 13 and 14), in view of the dependence of these claims from claim 30, Applicants submit one of ordinary skill in the art would be able to ascertain the meaning of "plurality of coordinate areas" when read in light of the specification, and therefore respectfully request the Examiner to withdraw this §112, second paragraph, rejection of claims 34 and 36. Moreover, regarding claim 36, Applicants submit that, when read in light of the specification, for example, at least, at paragraphs [045-046], the term "associated" is not indefinite to one of ordinary skill in the art.

Regarding claim 37 (Office Action: Item 15), without conceding the propriety of this rejection, Applicants have amended claim 37 to advance the prosecution of the application. Applicants submit one of ordinary skill in the art would be able to ascertain the meaning of this claim when read in light of the specification, and respectfully request the Examiner to withdraw the §112, second paragraph, rejection of claim 37. Moreover, Applicants are not obliged under §112, second paragraph, to claim the functionality of the structure recited in an apparatus claim.

Regarding claims 38-41 (Office Action: Item 16), Applicants have amended claims 38-41 to modify their respective claim dependencies. Applicants submit the lack of antecedent basis is cured for the term "communications interface" and therefore claims 38-42 are not indefinite. Applicants therefore respectfully request the Examiner to withdraw the §112, second paragraph rejection of claims 38-41.

Regarding claims 42, 46, 48 and 50-52 (Office Action: Items 17, 18 and 21), without conceding the propriety of the Examiner's rejection, Applicants have amended claims 42, 46, 48 and 50 to remove the term "only" in order to advance the prosecution of the application. Applicants further submit that this amendment in no way narrows the scope of these claims. Applicants therefore respectfully request the Examiner to withdraw the §112, second paragraph, rejection of claims 42, 46 48 and 50.

Regarding claims 44 and 46-51 (Office Action: Items 19, 20 and 21), Applicants submit that the explicit recitation of the order of the steps is not required to render a method claim definite. When read in light of the specification, one of ordinary skill in the art can ascertain one or more orders of the steps within the metes and bounds of the claimed subject matter. Moreover, Applicants submit they are not obligated to set forth any specific order for

the recited steps under \$112, second paragraph, and request the Examiner to withdraw the rejection to these claims. If the Examiner maintains the \$112, second paragraph, rejection based upon this ground, Applicants respectfully request the Examiner provide competent legal authority to justify the basis for the rejection.

Claim Rejection - 35 U.S.C \$102(b)

The Examiner rejected claims 11, 13-27, 29, 30 and 32-37 under 35 U.S.C \$102(b) as being anticipated by U.S. Pat. No. 5,892,824 to Beatson et al. ("Beatson"). Applicants respectfully traverse the \$102 rejection because the prior art cited by the Examiner fails to disclose all of the features recited in these claims.

Beaston merely discloses a device for capturing and verifying a signature at a point of sale which utilizes an integrated card. Specifically, Beaston discloses a signature device 64 which is connected to electronic transaction devices 52, 54. Paper receipts are placed in the signature device 64 and signed by the customer. The signature device 64 captures an electronic image of the customer's signature and stores it in internal memory (col. 8, lines 40-52; Fig. 1). The signature is captured using an electromagnetic sensing technique for sensing the position of a pen 74 containing electrical coils that emanate and/or receive electromagnetic fields (col. 10, lines 12-18; Fig. 4). The customer's signature may be verified through the use of an

electronic IC card 66 or by obtaining a verification template over a network 58 (col. 9, lines 1-45). The IC card 66 stores information regarding the customer's signature which may be used by the signature device 64 for verification of the signature. Specifically, the IC card 66 stores account number, signature templates and template authentication codes in non-volatile memory 254, and signature image information in write once/read many memory storage portion 256 (col. 14, lines 16-24; Fig. 6).

However, Beatson fails to disclose, at least, "a checking device which determines whether the at least one pair of coordinates are associated with at least one coordinate area for authorizing access to the access-protected unit," as recited in claim 11, and "determine whether the at least one pair of coordinates are associated with the stored information for authorizing access to the access-protected unit," as recited in claim 30.

Accordingly, Applicants respectfully request the Examiner to withdraw the §102(b) rejection of claims 11 and 30. Claims 13-27 and 29, which depend from claim 11, and claims 32-37, which depend from claim 30, are allowable for at least the reasons provided above for allowable claims 11 and 30. Applicants therefore respectfully request the Examiner to withdraw the rejection of these claims.



Moreover, regarding claim 17 (Office Action: Item 37), Applicants traverse the Examiner's assertion that it is inherent that "the user's stored sequence of coordinate pairs represents a function with Beatson's access protected unit." Applicants request that the Examiner provide a competent prior art reference to in support of the grounds of the rejection of claim 17, if any exist, or withdraw the rejection.

Finally, regarding claim 20 (Office Action: Item 43), Applicants respectfully remind the Examiner that to establish a prima facie case of anticipation, each and every element must be present in the prior art reference. Applicants take issue with the Examiner's position that "the access protected unit is a digital pen is given no patentable weight as being an item that is protected by the system which is controlling a user's access to the digital pen." Applicants respectfully request that the Examiner give each claim recitation its proper consideration, and interpretation in light of the specification.

Claim Rejections - 35 U.S.C §103(a)

The Examiner rejected claims 28 and 42 under 35 U.S.C §103(a) as being unpatentable over Beaton in view of "common practice". Applicants traverse the Examiner's taking of Official Notice.

The Examiner is respectfully reminded of the provisions of MPEP § 2144.03, and the precedents provided in *Dickinson v. Zurko*,

527 U.S. 150, 50 USPQ2d 1930 (1999) and In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. It is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principle evidence upon which a rejection is based. Accordingly, Applicant traverses the Official Notice and requests that the Examiner either cite a competent prior art reference in substantiation of these conclusions, supply a personal affidavit supporting the Examiner's allegation, or else withdraw the rejection.

The Examiner rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Beatson in view of U.S. Patent No. 5,852,434 to Sekendur ("Sekendur"). Applicants respectfully traverse this rejection.

Claim 12 depends from allowable claim 11, and as such, includes all of the features recited therein. As provided above, Beatson fails to teach or suggest, at least, "a checking device which determines whether the at least one pair of coordinates are associated with at least one coordinate area for authorizing access to the access-protected unit" as required by claim 12.

Sekendur fails to cure the deficiencies of Beatson in this respect. Sekendur merely teaches a digitizer which determines absolute position by reading a data surface printed on a paper surface.

Accordingly, Applicants respectfully request the Examiner to withdraw the \$103 rejection of claim 12.

Provisional Claim Rejection - Non-Statutory Double Patenting

The Examiner provisionally rejected claims 1-8 and 43-50 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of co-pending Application No. 09/746,781 in view of Beatson. Applicants respectfully traverse this provisional rejection.

Applicants note that on December 28, 2004, Application No. 09/746,781 (hereinafter '781) issued as U.S. Pat. No. 6,836,555 (hereinafter '555). Applicants submit that claim 11, as presented in '781, was amended during prosecution and is not presented in the same form in '555.

Accordingly, Applicants respectfully submit the provisional rejection is hereby moot because it uses claims which no longer exist as a basis for a double patenting rejection. Applicants therefore request that the Examiner withdraw the provisional rejection, and reconsider the double patenting rejection in light of the newly issued patent '555.

Moreover, Applicants traverse the Examiner's taking Official Notice in the rejections of the following claims: in the rejection of claim 1 (Office Action: Item 80f) wherein it is asserted that it is "common practice in the art to replace one authentication parameter with another authentication parameter when one is available;" in the rejection of claim 8 (Office Action: Item 92a) wherein it is asserted that it is "common practice in the art shift (as desired and with choices) components from one module to another module" (sic); and in the rejection of claim 31 (Office Action: Item 97f) wherein it is asserted that it is "common practice in the art to replace one authentication parameter with another authentication parameter when one is available." Additionally, Applicants traverse any other taking of Official Notice in the Office Action which is not explicitly set forth above. Applicants request the Examiner to provide a competent prior art reference in support of these assertions, if any exists, or withdraw the rejections.

Moreover, Applicants traverse the Examiners assertion of inherency in the rejection of claim 43 (Office Action: Item 94a) and request the Examiner provide a prior art reference or withdraw the rejection.

Conclusion

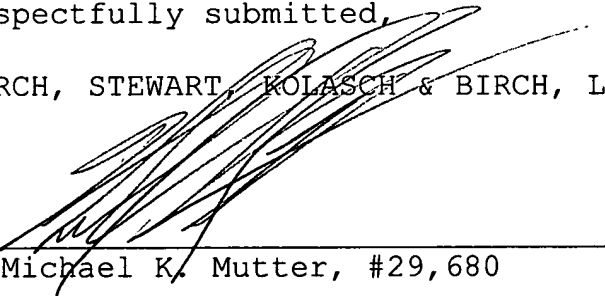
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael K. Mutter (Reg. No. 29,680) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

  
Michael K. Mutter, #29,680

  
MKM/JAV  
3782-0113

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000